UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,904	09/30/2003	Jeyhan Karaoguz	14330US02	6131

23446 7590 04/16/2008
MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER	
RYAN, PATRICK A	

ART UNIT	PAPER NUMBER
2623	

MAIL DATE	DELIVERY MODE
04/16/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/675,904	KARAOGUZ ET AL.	
	Examiner	Art Unit	
	PATRICK A. RYAN	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *02/20/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is made in response to "Reply to Office Action of October 17, 2007" received January 17, 2008. Applicant has amended Claims 1-31 as of January 17, 2008. As amended Claims 1-31 are presented for examination.

2. Applicant has amended Paragraphs [01-02] to replace all Attorney Docket Numbers with the corresponding US Application Numbers.

3. Applicant has amended Paragraph [31] to identify "user's home" as element 3 in relation to Fig. 1A. In addition, Applicant has made grammatical adjustments to Paragraph [31].

Response to Arguments

4. Applicant's arguments, see Pages 15-17 of Applicants Reply, filed January 17, 2008, with respect to objections to Information Disclosure Statement and Specification, have been fully considered and are persuasive.

5. The Examiner acknowledges Applicant's citation in Paragraph [44] of US Patent Application No. 10/675382 (previously cited as Attorney Docket No. 14276US02) as considered related to the instant application and not a prior art reference. Therefore, the requirement of an Information Disclosure Statement has been withdrawn.

6. The Examiner acknowledges that the processors stated in Claim 31 are also stated in Paragraph [12] and [91] of the Specification. In addition, the Examiner acknowledges Applicant intention of using the terms "media peripheral", "computer",

and "storage system" as well known terms in the art of processor technology. The objection to the Specification for failing to provide proper antecedent basis for subject matter of Claim 31 has been withdrawn.

6. Applicant's arguments, see Pages 17-24 of Applicants Reply, filed January 17, 2008, with respect to the rejection of Claims 1-31 under 35 USC 102(b) as being anticipated by Novak (US Patent Application Publication No. 2002/0104099) have been fully considered but they are not persuasive.

7. In reference to Claim 1, Applicant submits that Novak does not disclose or suggest, in reference to all steps of Figure 11, the limitation of "wherein said media channel may be pushed from said first geographic location to a second geographic location" (Applicant's Reply Page 19). Applicant supports this position by stating that "Novak discloses that media can be uploaded to a server and a network provider may communicate the uploaded media to an end user." (Applicant's Reply Page 19). The Examiner respectfully disagrees.

8. The Examiner submits Paragraph [61] of Applicant's Disclosure to be representative of Applicant's intended use of the word "Push". In particular, Applicant states:

> "The media exchange network allows users to effectively become their own broadcasters from their own homes by creating their own media channels and pushing those media channels to other authorized users on the media exchange network..." (Page 18 Paragraph [61])

In light of the specification, the Examiner interprets Applicant's uses of "channel [that] may be pushed" to mean providing a path of access through the network (authorized

users) in order to display a list of available media (user created media channels) to a receiving user in a similar manner to broadcast television (become their own broadcasters).

The Examiner disagrees that Novak does not teach a first and second geographic location. Novak teaches "a first geographic location" in upload source 122 of Fig. 2, which Novak discloses in Paragraph [56] may be an individual or consumer, and "a second geographic location" in set top box 152, which is also shown in Fig. 2.

In addition, the Examiner disagrees that Novak does not teach the act of pushing a media channel from the first geographic location to the second geographic location. With reference to Fig. 11, Novak teaches pushing a media channel from a first geographic location in step 1104 to a second geographic location in step 1110. Upload source 122 provides access to information related to the media objects by way of interface 702, as Novak disclosed in Paragraphs [78] and [68]. In addition, Novak discloses that this access may be embodied into pay-per-view methods and treated as a video-on-demand application, Paragraph [68]. In step 1110, the media channel is pushed to the second geographic location, wherein the end-user is subscribed to the media channel and provided access to the EPG 153 of Figure 9, as Novak discloses in Paragraph [80]. The Examiner notes that EPG 153 contains listings 908, which identify media programs that upload source 122 created and is now making available to end users for viewing, as Novak discloses in Paragraph [75]. In view of the above reasoning, the Examiner submits the Novak does teach the limitation "wherein said

media channel may be pushed from said first location to a second geographic location" as recited in Applicant's Claim 1.

9. Applicant further submits that Novak does not disclose or suggest the limitation of "determining a schedule for presenting said one or both of personal media and/or broadcast media in said media channel" and refers to Examiner's citation of step 1108 "Link Uploaded Media Objects to Local Studio and/or Cable Service Provider" of Figure 11 of Novak for support (Applicant's Reply Page 19). In addition, Applicant submits that Novak does not disclose "presenting a schedule which includes personal and/or broadcast media, in a media guide" and refers to Examiner's citation and refers to Examiner's citation of 1116 "Stream Media Program to Client Terminal of End User" of Figure 11 of Novak for support (Applicant's Reply Page 19). The Examiner respectfully disagrees.

It is the Examiners position that Novak's "synthetic channel" is equivalent to Applicant's "personal media" channel because Novak describes that media within a synthetic channel, such as "Joe's TV Channel" 908 of Figure 9, "can be scheduled for replay or repeat..." and "[t]he replay can be scheduled explicitly by the individual, or done automatically by software of the interface 702" see Paragraph [64]. Therefore, an individual at upload source 122 may customize the media content and media presentation times in EPG 153, which is presented to the end-user at STB 152 (step 1112 of Novak). The Examiner notes that Novak's step 1108 is used to allow "parties to recognize the availability of the media programs", as disclosed in Paragraph [79]. This availability is made evident to the end-user by way of EPG 153. In addition, customized

media content may include elements such as “birthday video” or “baby pictures”, as Novak discloses in Paragraphs [64] and [65]. In view of the above reasoning, the Examiner submits that Novak does teach the limitation “determining a schedule for presenting said one or both of personal media and/or broadcast media in said media channel”.

The Examiner submits that in Novak's Figure 11 the media content presented to the user at step 1116 was previously selected by the end-user in step 1112, as Novak describes in Paragraphs [84]-[86]. The end-user is presented with a schedule in a media guide, in the form of EPG 153 shown in Figure 9, as described in Paragraph [83]. As shown in Figure 9, Novak displays both personal media (Joe’s TV Channel 908) and broadcast media (channels of element 902) in EPG 153, as described in Paragraph [74]. It is therefore the Examiner's position that Novak teaches “presenting a schedule which includes personal and/or broadcast media, in a media guide".

10. Applicant’s arguments regarding the limitations of "determining a schedule for presenting said one or both of personal media and/or broadcast media in said media channel " and "presenting a schedule which includes personal and/or broadcast media, in a media guide” are moot in view of new grounds of rejection.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1, 11, and 21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 11, and 21 of copending Application No. (10/675467 "application ('467)").

Although the conflicting claims are not identical, they are not patentably distinct from each other because each application is directed towards a method (Claim 1), an article of manufacture (Claim 11), and a system (Claim 21) for presenting, scheduling, and controlling media within a media channel.

In regards to Claim 1, the instant application recites the limitation of "presenting… one or both of personal media and/or broadcast media in a media guide" as compared to application ('467) reciting the limitation of "presenting... one or more of media, data, and/or service". The "presenting personal media" and the "presenting broadcast media" of the instant application are commensurate in scope to "presenting media" as recited in application ('467). Both the instant application and application ('467) recite the limitation "media channel may be pushed from [a] first geographic location to a second geographic location". Therefore, both the instant application and application ('467) are directed toward the presentation of a media that is presented by transferring a media channel from one location to another.

In addition, referring to Claim 1, the instant application recites the limitation of "determining a schedule for presenting... media in [a] media channel" as compared to application ('467) reciting the limitation of "selecting at least one customized media channel…". The "determining a schedule" of the instant application is commensurate in scope to the "selecting" as recited in application ('467). Therefore, both the instant application and application ('467) are directed toward the scheduling of a media in a media channel wherein the media channel is to be transferred from one location to another.

Referring again to Claim 1, the instant application recites the limitation of "determining one or both of personal media and/or broadcast media that is to be presented in a media channel" as compared to application ('467) reciting the limitation of "identifying one or more of media, data, and/or service... for media channel". Therefore, both the instant application and application ('467) are directed toward controlling a media to be included in a media channel wherein the media channel is to be transferred from one location to another.

Based in the above reasoning, Claim 1 of the instant application and Claim 1 of application ('467) contain only obvious variations in the scope of claimed subject matter and are directed toward the same method of presenting, scheduling, and controlling media with in a media channel. In addition, Claims 11 and 21 of both the instant application and application ('467) are directed toward an article of manufacture and a system for implementing the method of Claim 1, therefore the reasoning above is also applied to Claims 11 and 21 of the instant application as compared to Claims 11 and 21 of application ('467). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

> applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1-31 are rejected under 35 U.S.C 102(e) as being anticipated by Novak, (US Patent Application Publication 2002/0104099).

15. In reference to Claim 1, Novak teaches a method of customizing a channel interface (shown in Figure 11 as described in Paragraphs [0078-0086]), the method comprising: determining one or both of personal media and/or broadcast media that is to be presented in a media channel ("broadcast" or "synthetic" channel of Figure 8 as described in Paragraph [0071]); determining a schedule for presenting one or both of personal media and/or broadcast media (block 1108 of Figure 11 as described in Paragraph [0079], with further reference to Paragraph [0064]) in the media channel; and presenting, at a first geographic location (upload source 122, as described in Paragraph [56]), the schedule comprising the one or both of personal media and/or broadcast media in a media guide (block 1116 of Figure 11 as described in Paragraph [0086], with further reference to block 1112 as described in Paragraph [0084]), wherein the media channel may be pushed from the first geographic location to a second geographic location (step 1104 to step 1110 of Figure 11, as described in Paragraphs [78]-[80] and with further reference to Paragraph [75] describing operations of "second location" STB 152).

16. In reference to Claim 2, Novak teaches a method of presenting the media guide comprising representations of one or both of personal media and broadcast media in a

graphical user interface (EPG 802 of Figure 8 as described in Paragraphs [0071 and/or 0072]).

17. In reference to Claim 3, Novak teaches a method wherein the graphical user interface contains one or both of aural and/or visual representations comprising one or more of audio, text, video, and/or graphics of one or both of personal media and/or broadcast media (display screen 1004 of Figure 10 as described in Paragraph [0076], Lines 4-10).

18. In reference to Claim 4, Novak teaches a method of controlling the graphical user interface by one or more of a keyboard, a mouse, a remote control, and/or a microphone (buttons 172 and 174 of remote control 158 as described in Paragraph [0073], Lines 4-10).

19. In reference to Claims 5 and 9, Novak teaches a method wherein the schedule correlates one or both of personal media and/or broadcast media to one or more of a time, a day, and/or a year (listings 908 of Figure 9 as described in Paragraph [0074] lines 10-13) for the presentation of the one or more of personal media and/or broadcast media in the media channel.

20. In reference to Claim 6, Novak teaches a method of selecting the one or both of personal media and/or broadcast media (buttons 172 and 174 of remote control 158 as described in Paragraph [0073], Lines 4-10) from a list of sources ("underlying component" of EPG 802 as described in Paragraph [0072]).

21. In reference to Claim 7, Novak teaches a method of displaying access and control functions for controlling the one or more of personal media and/or broadcast

media from within the media guide ("automatic features" of interface 702 as described in Paragraph [0066]).

22. In reference to Claim 8, Novak teaches a method of rescheduling when the one or more of personal media and/or broadcast media is to be presented in the media channel ("re-sequence" action of interface 702 as described in Paragraph [0065], Lines 6-14).

23. In reference to Claim 10, Novak teaches a method of updating one or more of a time, a day, and/or a year within the media guide (upload/update button 712 of interface 702 as described in Paragraph [0067]), when the one or both of personal media and/or broadcast media is to be presented in the media channel.

24. In reference to Claims 11-20, Novak teaches a machine-readable storage (described in Paragraph [0077], Lines 4-10) having stored thereon, a computer program having at least one code section for programming media content in a distributed media network (using "token" program described in Paragraph [0058] Lines 1-10), the at least one code section being executable by a machine (STB 152 described in Paragraph [0077] Lines 10-14) for causing the machine to perform the method of Claims 1 through 10.

25. In reference to Claim 21-30, Novak teaches a system for customizing a channel interface comprising at least one processor that receives at least one indication of one or both of personal media and/or broadcast media that is to be presented in a media channel (STB 152 executing the flow diagram of Figure 11 as described in Paragraphs

[0077-0086]), wherein the system and processor execute the method of Claims 1 through 10.

26. In reference to claim 31, Novak teaches a processor that is a media processing system processor (Paragraph [0085] describing the STB 152 executing flow diagram block 1114).

Conclusion

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICK A. RYAN whose telephone number is (571)270-5086. The examiner can normally be reached on Mon to Thur, 8:00am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. A. R./
Examiner, Art Unit 2623
Wednesday, April 16, 2008

/Scott Beliveau/

Supervisory Patent Examiner, Art Unit 2623